

Introduction

Claims 19 and 145-152 are pending in the instant application.

New Claims 153-156 have been added herewith. Applicants submit that these amendments do not add new matter to the present specification. Support for these new claims can be found, e.g., on page 20, lines 10-19.

Applicants appreciably note that the prior rejection of claims 147, 148, 151 and 152 under 35 U.S.C. §112, 1st paragraph has been withdrawn.

In the present office action, the “abstract of the disclosure” stands objected to as incorrect. Applicants have amended their specification herewith and respectfully submit that this objection has been obviated.

In the present office action, the Examiner has also alleged that there is a defect in Applicant’s priority claim rendering it ineffective and has examined the present claims based on a priority date of February 24, 2004, the present application’s filing date. As a result of examining the present claims based on an assumed priority date of February 24, 2004, the Examiner has entered the following three rejections.

Claims 19 and 145-152 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,303,634 (Cohen).

Claims 19 and 145-152 are rejected under 35 U.S.C. §102(b) as being anticipated by US2002/0019418 A1 (Cohen II).

Claims 19 and 145-152 are rejected under 35 U.S.C. §102(b) as being anticipated by Cummings, et al., JAMA, 281:2189-2197, 1999 (Cummings).

Remarks**Priority**

The Examiner Interview Summary reflects the substance of the telephonic interview that pertains to Applicant's allegedly defective priority claim as follows:

Examiner notified Mr. Voy that upon further review of the record, the benefit claim under 35 U.S.C. 120 to Non-Provisional Application No. 09/931,159 is invalid. The '159 application became abandoned on 11/28/2003 due to failure to respond to a Non-Final Office Action mailed 8/26/2003. According to USPTO records, no extension of time was filed in the '159 application. As such, the instant application and the '159 application were not co-pending at the time the instant application was filed on 2/24/2004 and the continuity of the instant application to all prior filed applications (both Non-Provisional and Provisional) has been broken.

In order to remedy the situation, the Examiner suggested, as accurately characterized by the Examiner's Interview Summary, "that a petition to revive the 09/931,159 application ... be submitted for the purpose of claiming priority to the '159 application and [to assess] appropriate fees"

It should be further noted, however, that in that telephonic interview when this issue was brought to the attention of Applicant's attorney, Applicant's attorney expressed surprise. Moreover, the Examiner agreed with Applicant's attorney that from the record it did not appear that the Patent and Trademark Office (the Office) or Applicant's attorneys were aware of this issue until it was uncovered by the present Examiner.

The Need for a Petition to Revive

Applicants respectfully submit that under the present circumstances, requiring Applicant to:

- a) file a petition to revive the unintentionally abandoned '159 application;
 - b) pay one thousand five hundred dollars in support of that petition (the current fees for such a petition); and to
 - c) pay at least nine hundred fifty dollars (the fees due in February 2004) for an "extension for reply within third month" in the '159 application;
- in order to perfect the present priority claim is unnecessary in view of the following.

According to the "Fee Transmittal" that accompanied the present application, the Office Commissioner was authorized to charge the "indicated fees", that is, the Large Entity

Utility filing fee of seven hundred seventy dollars, to the deposit account of Eli Lilly and Company (the assignee of the present application). According to that fee transmittal, the Commissioner was also authorized to “Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17.” Applicants note that the fees associated with extensions for reply are governed by 37 CFR §1.17.

According to the “Utility Patent Application Transmittal” that also accompanied the present application, the present application was a “continuation” of “prior application 09/931,159”. The Office acknowledged that Applicants were claiming priority to the ‘159 application as a continuation thereof in the present application’s Filing Receipt. The “Domestic Priority as claimed by applicant” section from that Filing Receipt states, “This application is a CON [continuation] of 09/931,159”.

According to Manual of Patent Examining Procedure at section 201.07, “A continuation is a second application for the same invention claimed in a prior nonprovisional application **and filed before the original prior application becomes abandoned** or patented.” Emphasis added. As the Examiner has correctly noted, the only way that the present application can be a “continuation” of the ‘159 application, and thus benefit from a priority claim to it, is for the present application to have been filed “before the [‘159] application becomes abandoned”.

Since the ‘159 application had a pending office action with an expired shortened statutory period for reply when the present application was filed, the ‘159 application was technically, but not statutorily abandoned¹, on the day the present application was filed². Thus, the payment of a three-month extension of time required to render the ‘159 application formally active at the time the present case was filed, **was a fee required under 37 CFR 1.17** to effect Applicants intentions specifically enumerated in the papers that accompanied the present application. Although Applicant regrettably did not have a separate line item in their papers for this three-month extension, Applicant respectfully submits that its presence nonetheless therein, at the time the present case was filed, should be acknowledged.

In view of the above, Applicants respectfully submit that to the extent that Eli Lilly and Company was never charged the fees associated with securing a three-month extension to reply in the ‘159 application, that the Office assess those charges presently. Applicants’ respectfully assert that the Office should also presently acknowledge Applicants’ priority claim to the ‘159 application. If the Office is agreeable to the course outlined above,

¹ The six-month statutory period for reply in the ‘159 application expired on February 26, 2004.

² The present application was filed on February 24, 2004.

Applicants hereby expressly authorize the Office to assess and charge those fees presently under Deposit Account Number 05-0840.

Anticipation in View of Cohen, Cohen II and/or Cummings

Applicants assert that perfection of priority in the present case renders all the presently pending rejections moot as none of the documents cited against the present application published before Applicant's asserted effective filing date of October 30, 1996. Similarly, Applicants further assert that new Claims 153-156 are also entitled to an effective filing date of October 30, 1996 and as such are not subject to an rejection under 35 U.S.C. §102(b) in view of Cohen, Cohen II and/or Cummings.

Conclusion

Applicants respectfully request that the Office acknowledge Applicants' priority claim, assess and charge fees for a three month extension to reply, and reconsider and withdraw the pending rejections.

Respectfully submitted,

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